

# Notice of Allowability

Application No.

10/651,440

Examiner

Russell Kallis

Applicant(s)

EBY, WILLIAM H.

Art Unit

1638

## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 6/08/2005.
2. ☒ The allowed claim(s) is/are 1-8,20,23-36(renumbered 1-23).
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☒ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 4/15/2005
4. ☒ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date 8/05/2005.
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

### EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Kenyon Schuett on 8/05/2005.

The application has been amended as follows:

In the specification:

On page 11, line 12, delete "medicated" and insert --mediated--.

On page 12, line 27, delete "(1990<" and insert --(1990)--.

On page 18, line 11, delete ", the contents of which are hereby incorporated by reference".

On page 19, line 7, delete "ost" and insert --post--.

On page 19, line 25, delete ", the respective contents of which are hereby incorporated by reference".

On page 22, line 2, delete "stearoyl" and insert --stearyl--.

On page 24, line 17, delete "Tissue Culture of Soybeans" and insert --Single Gene Conversions--.

On page 26, line 17, after "the" and before "disclosures" insert "U.S. Patent".

Art Unit: 1638

In the claims:

In Claim 6, line 1, delete “according to” and insert --of--.

Claim 20 (currently amended) A method for producing a soybean plant that contains in its genetic material a transgene, comprising crossing the soybean plant of claim 2 with [either a second] another soybean plant [of another cultivar] which contains a transgene, [or a transformed soybean plant of the soybean cultivar S022217 so that] wherein the genetic material of the progeny that result from the cross contains [a] said transgene [operably linked to a regulatory element], and wherein said transgene is expressed and confers a trait selected from the group consisting of male sterility, herbicide resistance, insect resistance, and disease resistance.

Claim 28 (currently amended) A method of producing a soybean plant with modified fatty acid metabolism or modified carbohydrate metabolism wherein the method comprises transforming the soybean plant of claim 2 with a transgene encoding a protein selected from the group consisting of fructosyltransferase, levansucrase,  $\alpha$ -amylase, invertase, and starch branching enzyme or encoding an antisense of stearyl-ACP desaturase, wherein the transgene is expressed and the fatty acid metabolism or the carbohydrate metabolism of the soybean plant is modified.

Claim 30 (currently amended) A method of introducing a desired single gene trait into soybean cultivar S022217 wherein the method comprises:

(a) crossing the S022217 plants, grown from seed deposited under ATCC Accession No. PTA-\_\_\_\_, with plants of another soybean cultivar that comprise and express a desired single gene trait to produce progeny plants, wherein the desired single gene trait is selected from the group consisting of male sterility, modified fatty acid metabolism, modified carbohydrate

Art Unit: 1638

metabolism, herbicide resistance, insect resistance and resistance to bacterial, fungal or viral disease;

(b) selecting one or more progeny plants that have and express the desired single gene trait to produce selected progeny plants;

(c) crossing the selected progeny plants with the S022217 plants to produce backcross progeny plants;

(d) selecting for backcross progeny plants that have and express the desired single gene trait and physiological and morphological characteristics of soybean cultivar S022217 to produce selected backcross progeny plants; and

(e) repeating steps (c) and (d) three or more times in succession to produce selected fourth or higher backcross progeny plants that comprise and express the desired single gene trait and all of the physiological and morphological characteristics of soybean cultivar S022217, wherein a representative number of seed of said soybean cultivar was deposited under ATCC Accession No. PTA-\_\_\_\_\_ [as described in the VARIETY DESCRIPTION INFORMATION].

Claim 31 (currently amended) A plant produced by the method of claim 30, wherein the plant has the desired single gene trait and all of the physiological and morphological characteristics of soybean cultivar S022217, wherein a representative number of seed of said soybean cultivar was deposited under ATCC Accession No. PTA-\_\_\_\_\_ [as described in the VARIETY DESCRIPTION INFORMATION].

In Claim 32, line 1, after “desired” insert --single gene--.

In Claim 33, line 1, after “desired” insert --single gene--.

In Claim 34, line 1, after “desired” insert --single gene--.

Art Unit: 1638

In Claim 36, line 2, delete "cytoplasmic" and "that confers male sterility".

**REQUIREMENT OF ALLOWANCE UNDER 37 CFR §§ 1.801-1.809**

The Deposit Statement in the response filed June 8, 2005 (pages 7-8) is deemed in accordance with 37 CFR §§ 1.801-1.809. Therefore, no 35 USC § 112, first paragraph rejection has been maintained even though it is apparent that S022217 soybean seed is essential to the claimed invention and that the deposit is necessary for an adequate written description and enablement for the claimed invention.

Since the application is otherwise in condition for allowance except for the needed deposit of S022217 seed and since the Office has received written assurance that an acceptable deposit will be made on or before payment of the issue fee, the Office is authorized to mail Applicant a Notice of Allowance and Issue Fee Due together with a requirement that the needed deposit be made within THREE (3) MONTHS of the mail date of this letter (see 37 CFR § 1.809(c)).

Under 37 CFR 1.809(c)(d) an applicant is required to make a deposit of seed within three months after the mailing date of the Notice Of Allowance and Issue Fee Due. The period for satisfying this requirement is extendible under § 1.136, however, failure to make the needed deposit of seeds of S022217 will result in abandonment of the application for failure to prosecute. The deposit statement in the specification, and all claims which refer to the instant seeds by name, must be amended to include the deposit accession number. In the instant application claims 1, 2, 7, 30 and 31 must be amended to recite the deposit accession number. These amendments should be submitted before the payment of the issue fee as an Amendment After Allowance under 37 CFR 1.312. If the amendment is received after the payment of the issue fee the same should be made under the provisions of 37 CFR 1.312(a) and a petition filed under 37 CFR 1.183 to waive the requirement of 37 CFR 1.312 that the amendment be filed before or with payment of the issue fee, that is, it must be accompanied by a fee in accordance with 37 CFR 1.17(i) and a petition which includes "a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented and why justice requires waiver of the rule"). Finally, the statement of deposit in the specification shall contain:

- (1) The accession number for the deposit(s);
- (2) The date of the deposit(s);
- (3) A description of the deposited biological material sufficient to specifically identify and to permit examination; and
- (4) The name and address of the depository. (See 37 CFR 1.809(d)).

Art Unit: 1638

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Russell Kallis Ph.D.  
August 3, 2005

**RUSSELL P. KALLIS, PH.D.**  
**PATENT EXAMINER**

*Russell Kallis*